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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,191

06/25/2004

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

06/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,191	Applicant(s) SANO, MASAHIRO	
	Examiner Geoffrey L. Knable	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 28, 2008 (as reiterated in RCE request filed April 2, 2008) has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 3-6, 8, 9, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, line 11, it is defined that the protruding portions include "at least one of a character and a mark" whereas in line 15, it is defined that "each of the protruding portions forms a character." These seemingly conflicting definitions render the claim indefinite.

In the last 5 lines of claim 8, references are made to "tops" and "bottoms" of the joined portions but without a clear indication of the relationship between the tops and bottoms. As such, it is not clear if this language necessarily requires that these be at different protruding amounts. It would be clearer if similar language to that used at lines 5-7 (with respect to the tops and bottoms of the decorative portion) be included in order to more clearly define these tops and bottoms.

4. Claims 1, 3-4, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over D204585 to Vizina.

Vizina discloses a tire including a sidewall having a serrated background pattern (e.g. note various cross-sections) defining what is considered to be a decorative portion having interconnected tops and bottoms in the protruding direction protruding from the sidewall. Further, protruding portions higher than the tops of the decorative portions are provided in the pattern (esp. fig. 5) with a flat portion between adjacent protruding parts (i.e. the flat part between each of the two raised portions in fig. 5) depicted as higher than the bottoms of the decorative portion (e.g. note again esp. fig. 5). This flat portion at present reads on the claimed "joined portion" that joins two protruding portions (i.e. the two raised areas adjacent thereto in fig. 5). Note further that although this joined portion is depicted at a single protruding height, the claimed reference to "bottoms" of the joined portion does not exclude this construction as there is no requirement for other parts at a different protruding amount. Although not working drawings, the relative heights depicted in this patent are considered to anticipate claim 1, or in any event, it would have been obvious to build a tire following the relative dimensional requirements of this reference, this rendering the claimed tire obvious in view of this teaching. As to claim 3, the flat portion between the two adjacent protruding portions in fig. 5 continuously extends between the adjacent protruding portions, each of these protruding "portions" defining a character (e.g. the letter "L"). As to claims 4 and 7, Vizina is applied for the same reasons as set forth in the last office action. As to claims 9 and 11, note again that the protruding portions define a group of letters "L" (fig. 2). It

is additionally noted that even the raised protruding *portion* within each overall letter “L” in fig. 5 also defines a letter “L” and thus a group of letters.

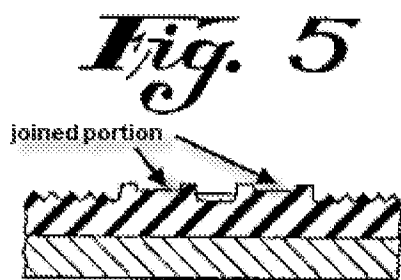
5. Claims 1, 2, 8, 9 and 13 are rejected under 35 U.S.C. 103(a) as obvious over Baker (US 6,053,228).

As to claim 1, Baker discloses a tire including a sidewall that includes what can be termed a decorative portion that includes tops and bottoms (part 100 in fig. 9) as well as protruding portions (46) higher than the decorative portion. As to the joined portion, it would have been an obvious alternative to combine the decorative portion (100) from fig. 9 with the internal serrated joined portion 54/56 of fig. 5 (compare also figs. 4 and 5 showing such internal structures to be obvious alternatives). In such case, bottoms “54” of the joined portions (i.e. as opposed to tops 56) would be higher than the bottoms of the decorative portion “100”. While parts “60” are also present that are not higher, parts “54” are still relative bottoms. A tire as required by claim 1 would therefore have been obvious. As to claim 2, the joined portion configured to include parts 54/56 in fig. 5 defines a high decorative portion with interconnected tops and bottoms. As to claim 8, the tops “56” are lower than the protruding portions 46 and bottoms “54” would be higher than the decorative portion “100” as already noted. As to claims 9 and 13, the protruding portions comprise letters.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over D204585 to Vizina or Baker (US 6,053,228) as applied above, and further in view of JP 2000-255224 (cited by applicant) and optionally Ratliff, Jr. (US 5,807,446) as applied in the last office action.

7. Applicant's arguments filed 2-28-2008 have been fully considered but they are not persuasive as regards the remaining rejections. The previous 35 USC 112 rejections have however been withdrawn in view of applicant's response. The previous rejections based upon Kemp have likewise been withdrawn. Rejections based upon Vizina and Baker are however maintained.

With respect to Vizina, it is argued that the bottoms of the flat portion between the characters "L" has the same level as the bottom of the decorative portion. This argument has been carefully considered but is unpersuasive. As noted in the statement of rejection, the flat portion between the protruding portions is depicted as higher than the decorative portion and therefore reads on the claimed joined or flat portion. Note the following marked up copy of fig. 5:



Each raised area adjacent the flat joined portion defines a protruding "portion", even if they appear to define with other portions an entire outline character.

With respect to Baker, it is argued that the "lowermost" part between the protruding surfaces 46 is at the same level as the outer surface of the tire. While not disputed, as noted in the statement of rejection, part "54", in the context of the fig. 5

configuration, define bottoms relative to tops "56". The claims do not exclude other lower portions.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey L. Knable/
Primary Examiner, Art Unit 1791

G. Knable
June 10, 2008